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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,516	11/12/1999	KIM B. ROBERTS	10799ROUS01U	9470

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EXAMINER

JONES, PRENELL P

ART UNIT	PAPER NUMBER
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2667

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/438,516

Applicant(s)

ROBERTS ET AL.

Examiner

Prenell P Jones

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2,4,7,10,11 and 13-33 is/are allowed.
- 6) ☐ Claim(s) 1,3,5,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Response to Arguments***

1. Applicant's arguments filed December 18, 2003 have been fully considered but they are not persuasive. Applicant argues that all the limitations are not met in the previous rejection regarding claims 1, 3, 5, 6, 8 and 9. Examiner disagrees. Hershey does (col. 4, line 45 thru col. 6, line 25) discloses transmitting in a high speed network wherein various network management protocols are used to enable communication among workstations, whereby the appropriate or a specific protocol is selected for reconfiguration and control management, and Hershey clearly shows in Fig. 2 a clock recovery circuit (34) for extracting data clock and circuits for extracting data signals (36, 130a).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hershey et al.

Regarding claims 1, 3, 5, 6, 8 and 9, Hershey discloses synchronization in a telecommunication system that includes (col. 1, line 16-54, col. 6, line 1-8) transmitting in a high speed network, transmission of multiple protocol signals associated with contemporary systems (col. 4, line 61-67, col. 5, line 27-46), FPGA (programmable link termination/programmable link instigation) which provides dynamic configuration of network in accordance with performance parameters and configuration of programmable device depends on protocol technology, and Hershey further discloses (Fig. 2, col. 5, line 13-61) a recovery circuit (34) for extracting data clock and circuits for extracting data signals (36, 130a).

***Allowable Subject Matter***

4. Claims 2, 4, 7, 10, 11 and 13-33 are allowed over prior art.

5. The following is a statement of reasons for the indication of allowable subject matter: As indicated in the previous office action claims 10, 11 and 13-33 are allowed because they contain allowable subject matter, and claims 2, 4 and 7 contain allowable subject matter, but are objected to, and would be allowable if rewritten to include all limitations of base claim and intervening claims. Applicant has amended claims 2 and 7, therefore, claims 2, 4 and 7 are allowed. Although the prior art, Hershey et al,

Art Unit: 2667

discloses synchronization in a telecommunication system that includes (col. 1, line 16-54, col. 6, line 1-8) transmitting in a high speed network, transmission of multiple protocol signals associated with contemporary systems (col. 4, line 61-67, col. 5, line 27-46), FPGA (programmable link termination/programmable link instigation) which provides dynamic configuration of network in accordance with performance parameters and configuration of programmable device depends on protocol technology, and Hershey further discloses (Fig. 2, col. 5, line 13-61) a recovery circuit (34) for extracting data clock and circuits for extracting data signals (36, 130a), he fail to teach/suggest set performance parameters include a previous section fail indicator, PLT translates user signal to a data signal whenever rate R corresponds to a provisioned first protocol and passes user signal unchanged whenever rate R is not recognized by processing unit, reverse mapping unit for rearranging the bits of a container of a second protocol into data signal of first protocol, detecting the rate (R) of a continuous digital signal and determining a first protocol corresponding to rate (R), translating set of performance parameters from first protocol to a second protocol characterizing container signal and providing translated set into container signal.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2667

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

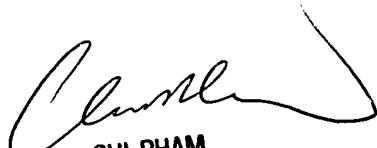
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell Jones whose telephone number is (703) 305-0630. The examiner can normally be reached on Monday thru Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Prenell Jones

2/18/04

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600 2/18/04